

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of )  
Trademark Registration No. 2,772,766 )  
For the Mark SAN DIMAS GUITARS THE )  
CALIFORNIA GUITAR COMPANY (Design) )  
Registration Date: October 7, 2003 )  
JACKSON/CHARVEL MANUFACTURING, )  
INC., )  
Petitioner, )  
v. )  
PRINS, LLOYD A., )  
Registrant-Respondent. )



03-31-2005

U.S. Patent & TMO/TM Mail Form #78

Cancellation No. 92042614

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
2900 Crystal Drive  
Arlington, Virginia 22202-3513

**PETITIONER'S RESPONSE IN OPPOSITION TO RESPONDENT'S  
MOTION FOR EXTENSION TO ANSWER**

Petitioner Jackson/Charvel Manufacturing, Inc. ("Jackson/Charvel") hereby responds in opposition to Respondent Lloyd A. Prins' ("Respondent") Motion for an Extension to Answer. Jackson/Charvel states as follows:

1. On October 24, 2003, counsel for Jackson/Charvel filed a Petition for Cancellation initiating the above-captioned matter.

**CERTIFICATE OF MAILING 37 C.F.R. 1.10**

I hereby certify that the enclosed Response in Opposition to Respondent's Motion for Extension to Answer and postcard are being deposited with the United States Postal Service with sufficient postage, using United States Postal Service's Express Mail Post Office to Addressee service, addressed to: United States Patent and Trademark Office, Trademark Trial and Appeal Board, 2900 Crystal Drive, Arlington, Virginia 22202 on the date indicated below.

Dated: March 31, 2004

  
Salvador K. Karottki

2. On November 11, 2003, the Trademark Trial and Appeal Board (the "Board") mailed Notice that it had received the Petition for Cancellation to both parties. Specifically, the Board mailed the Notice, attaching the Petition for Cancellation, to Respondent at the following address:

Prins, Lloyd A.  
2323 Via Saldivar  
Glendale, CA 91208

The Notice from the Board stated that Respondent's Answer was due forty (40) days after the November 11 mailing date thereof. A true and correct copy of the Board's Notice of November 11, 2003, is attached hereto as Exhibit A.

3. Under Patent and Trademark Rule 1.7, Respondent's Answer was due on December 22, 2003. Respondent did not file an Answer by that date and has still failed to file an Answer.

4. Pursuant to Rule 55(a) of the Federal Rules of Civil Procedure, Jackson/Charvel filed a Motion for Default Judgment Canceling Registration on January 26, 2004. The Board then entered a default against Respondent.

5. On February 24, 2004, the Board mailed a Notice of Default to the parties, stating that "[i]nasmuch as it appears that no answer has been filed, nor has respondent filed a motion to extend its time to answer, notice for default is hereby entered against respondent under Fed. R. Civ. P. 55(a)." The Trademark Trial and Appeal Board further stated, "Respondent is allowed until thirty days from the mailing date of this order to show cause why judgment by default should not be entered against respondent in accordance with Fed. R. Civ. P. 55(b)." A true and correct copy of the Board's Notice of Default of February 24, 2004, is attached hereto as Exhibit B.

6. Pursuant to Rule 55(c) of the Federal Rules of Civil Procedure, an entry of default may be set aside only "for good cause shown." The Board also specifically stated in its Notice of Default that Respondent must show cause why judgment by default should not be entered against Respondent by March 25, 2004. (*See* Exhibit B.)

7. On March 22, 2004, three months after his Answer was due, Respondent filed a Motion for an Extension to Answer and also to set aside the Board's entry of default. A true and correct copy of Respondent's Motion for an Extension to Answer ("Motion") is attached hereto as Exhibit C.

8. Respondent's Motion attaches no evidence, such as affidavits or other sworn testimony; rather, the Motion merely makes unsworn assertions and arguments. For example, Respondent's Motion asserts in a conclusory fashion that "notification of the proceedings and instructions for answering were never received." (*See* Exhibit C at ¶ 3.) Respondent's Motion does not even assert that Respondent's company, San Dimas Guitar Company, did not receive the mailing from the Board; rather, Respondent merely asserts that "Prins' [Respondent's] first knowledge of the petition for cancellation was in early February 2004." (*See id.* at ¶ 4.)

9. Importantly, Respondent's Motion admits that the Board "has the correct mailing address for [Respondent]." (*See id.*) Therefore, the Board sent the Notice and Jackson/Charvel's pleading to the correct address.

10. It is well-settled that a notice properly directed to the correct address via U.S. mail creates a presumption that the notice arrived at its destination and was received by the party to whom it was addressed. *Hagner v. United States*, 285 U.S. 427, 430 (1932) ("The rule is well settled that proof that a letter properly directed was placed in a post office creates a presumption that it reached its destination in usual time and was actually received by the person

whom it was addressed."); *Beck v. Somerset Technologies, Inc.*, 882 F.2d 993, 996 (5th Cir. 1989) (same); *Crude Oil Corp. v. Commissioner of Internal Revenue*, 161 F.2d 809, 810 (10th Cir. 1947) (same); *In re Rosage*, 189 B.R. 73, 79 (Bnkr. W.D. Pa. 1995) (same). In this case, therefore, it is presumed that Respondent received the Board's Notice mailed on November 11, 2003, along with Jackson/Charvel's Petition for Cancellation.

11. While the well-settled presumption that a notice properly directed to the correct address arrived at its destination and was received by the party to whom it was addressed is rebuttable, a party who seeks to overcome the presumption must submit *evidence*, such as affidavits or other sworn testimony. *Beck*, 882 F.2d at 996 (holding that a properly addressed letter deposited with the U.S. mail creates a presumption that the letter is received by the addressee, which shifts the burden of "producing *evidence* of non-delivery" to the party challenging the presumption (emphasis added)); *Fiore v. Giant Food Stores, Inc.*, No. 98-517, 1998 WL 254975, at \*2 (E.D. Pa. 1998) ("[A] party challenging the regularity of mail service has the burden to come forth with evidence, including affidavits, that calls into question the validity of the service."). Respondent did not submit any affidavits or actual evidence overcoming the presumption that he received the Board's Notice of November 11, 2003. The Motion contains only unsworn assertions and arguments.<sup>1</sup> Mere assertions in a motion "only supported by [Respondent's] unsworn protestations" fail to overcome the presumption that the properly addressed Notice was received by Respondent. *Fiore*, 1998 WL 254975, at \*2.

12. Even if Respondent had sworn to the information asserted in the Motion, however, Respondent would still fail to overcome the presumption that he received the Board's Notice, attaching Jackson/Charvel's pleading. "Mere denial by the addressee that it received the

---

<sup>1</sup> Respondent also attaches an unsigned letter that he alleges he sent to "the USPTO" which similarly contains only unsworn conclusory statements.

notice is insufficient to rebut the presumption that proper notice was given." *In re Rosage*, 189 B.R. at 79; *see also Eagle Bus. Mfg., Inc. v. Greyhound Lines, Inc.*, 62 F.3d 730, 735 (5th Cir. 1995). "[C]onclusory statements to the effect that 'I never got the pleading' will not overcome" the presumption of delivery and receipt by the addressee. *Fiore*, 1998 WL 254975, at \*2. At best, the Motion contains *only* conclusory assertions that Respondent "never got the pleading." The Motion assumes the Board sent the Notice to the correct address; however, Respondent merely asserts that he never personally received the Notice. Thus, even if sworn, Respondent's conclusory statements do not rebut the presumption that Respondent received the Board's Notice of November 11, 2003, and Jackson/Charvel's pleading.

13. Because Respondent's Motion does not attach any evidence and the Motion relies on only conclusory denials of receipt, Respondent cannot overcome the presumption that the Board's properly addressed Notice, attaching Jackson/Charvel's pleading, was received by him. Therefore, Respondent has not shown good cause why he did not timely Answer the Petition for Cancellation and why judgment by default should not be entered against him.

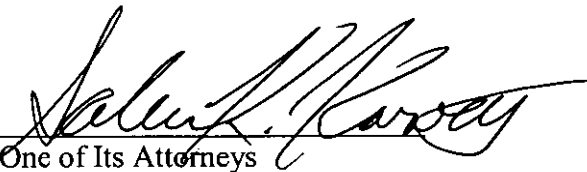
14. Pursuant to Rule 55(b) of the Federal Rules of Civil Procedure, the Board should enter judgment by default against Respondent and in favor of Jackson/Charvel. As a result of Respondent's default, the allegations contained in Respondent's Petition for Cancellation are deemed admitted. Jackson/Charvel's Petition for Cancellation alleges facts supporting a finding that Registration No. 2,772,766 should be cancelled. Therefore, the Board should enter judgment in favor of Jackson/Charvel, canceling Registration No. 2,772,766.

WHEREFORE, Petitioner Jackson/Charvel respectfully requests that the Board deny Respondent's Motion and enter a judgment by default in favor of Jackson/Charvel, thereby canceling Registration No. 2,772,766.

DATED: March 31, 2004

Respectfully submitted,

JACKSON/CHARVEL MANUFACTURING,  
INC.

By   
One of Its Attorneys

Oscar L. Alcantara  
Salvador K. Karottki  
GOLDBERG, KOHN, BELL, BLACK,  
ROSENBLOOM & MORITZ, LTD.  
55 East Monroe Street, Suite 3700  
Chicago, Illinois 60603  
(312) 201-4000



**UNITED STATES PATENT AND TRADEMARK  
OFFICE**

**Trademark Trial and Appeal Board**  
2900 Crystal Drive  
Arlington, Virginia 22202-3513

Mailed: November 11, 2003

Prins, Lloyd A.  
2323 Via Saldivar  
Glendale, CA 91208

Cancellation No. 92042614  
Reg. No. 2772766

Salvador K. Karottki  
Goldberg, Kohn, Bell, Black, Rosenbloom & Moritz, Ltd.  
55 East Monroe Street - Suite 3700  
Chicago, IL 60603

Jackson/Charvel Manufacturing,  
Inc.

V.

Prins, Lloyd A.

**Tracey Fleming, Legal Assistant.**

A petition, a copy of which is attached, has been filed to cancel the above-identified registration.

Proceedings will be conducted in accordance with the Trademark Rules of Practice.

**ANSWER IS DUE FORTY DAYS** after the mailing date hereof.  
(See Patent and Trademark Rule 1.7 for expiration date falling on Saturday, Sunday or a holiday).

Proceedings will be conducted in accordance with the Trademark Rules of Practice, set forth in Title 37, part 2, of the Code of Federal Regulations. The parties are reminded of the recent amendments to the Trademark Rules that became effective October 9, 1998. See Notice of Final Rulemaking published in the *Official Gazette* on September 29, 1998 at 1214 TMOG 145. Slight corrections to the rules, resulting in a correction notice, were published in the *Official Gazette* on October 20, 1998 at 1215 TMOG 64.



A copy of the recent amendments to the Trademark Rules, as well as the *Trademark Trial and Appeal Board Manual of Procedure* (TBMP), is available at <http://www.uspto.gov>.

Discovery and testimony periods are set as follows:

Discovery period to open: December 01, 2003

Discovery period to close: May 29, 2004

30-day testimony period for party  
in position of plaintiff to close: August 27, 2004

30-day testimony period for party  
in position of defendant to close: October 26, 2004

15-day rebuttal testimony period  
for plaintiff to close: December 10, 2004

A party must serve on the adverse party a copy of the transcript of any testimony taken during the party's testimony period, together with copies of documentary exhibits, within 30 days after completion of the taking of such testimony. See Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

**NOTE:** The Board allows parties to utilize telephone conferences to discuss or resolve many interlocutory matters that arise in inter partes cases. See the *Official Gazette* notice titled "Permanent Expansion of Telephone Conferencing on Interlocutory Matters in Inter Partes Cases Before the Trademark Trial and Appeal Board," 1235 TMOG 68 (June 20, 2000). A hard copy of the *Official Gazette* containing this notice is available for a fee from the Superintendent of Documents, U.S. Government Printing Office, Washington, D.C. 20402 (Telephone (202) 512-1800). The notice is also available at <http://www.uspto.gov>. Interlocutory matters which the Board agrees to discuss or decide by phone conference may be decided adversely to any party which fails to participate.

If the parties to this proceeding are also parties to other Board proceedings involving related marks or, during the pendency of this proceeding, they become parties to such proceedings, they should notify the Board immediately, so that the Board can consider consolidation of proceedings.

**New Developments at the Trademark Trial and Appeal Board**

TTAB forms for electronic filing of extensions of time to oppose, notices of opposition, and inter partes filings are now available at <http://estta.uspto.gov>. Images of TTAB proceeding files can be viewed using TTABVue at <http://ttabvue.uspto.gov>.

Parties should also be aware of changes in the rules affecting trademark matters, including rules of practice before the TTAB. See Rules of Practice for Trademark-Related Filings Under the Madrid Protocol Implementation Act, 68 Fed. R. 55,748 (September 26, 2003) (effective November 2, 2003) Reorganization of Correspondence and Other Provisions, 68 Fed. Reg. 48,286 (August 13, 2003) (effective September 12, 2003). Notices concerning the rules changes are available at [www.uspto.gov](http://www.uspto.gov).

**TTAB NOTI    CONCERNING CORRESPONDENCE    ADDRESS**  
**(TRADEMARK RULE 2.18)**

The Trademark Trial and Appeal Board will mail correspondence to only one address for each party.

If a party is located in the U.S., correspondence will be sent to the party's own address, unless (1) papers filed with the Board are filed by a party's attorney, (2) a written power of attorney is filed, (3) a written authorization of some other person entitled to be recognized is filed, or (4) the party requests in writing that correspondence be sent to another address. In these situations, correspondence will be sent, respectively, to (1) the attorney filing papers, (2) the attorney named in the power of attorney, (3) the other person designated in the written authorization, or (4) the other address specified by the party.

When one attorney or other authorized representative makes an appearance on behalf of a party, his address is noted on the proceeding file as the correspondence address. If a second attorney or other authorized representative makes an appearance on behalf of the party, and requests that correspondence be directed to him, the correspondence address on the proceeding file will be changed, and future correspondence will be sent to the second attorney or other authorized representative, rather than to the first one. If the second attorney or other authorized representative does not request that correspondence be sent to him, the Board will continue to send correspondence to the first attorney or authorized representative.

If a power of attorney from a party to one attorney has been filed, and thereafter another attorney or authorized representative makes an appearance on behalf of the party and asks that correspondence be sent to him, the second attorney or authorized representative will be required to submit authorization, from the party or from the first attorney, for the requested change in correspondence address.

If a power of attorney from a party to one attorney has been filed, and thereafter a power of attorney from the party to another attorney is filed, the second power of attorney will be construed as a written request to change the correspondence address from the first attorney to the second one, even if there is no revocation of the first power, unless the party or the first attorney directs otherwise. Likewise, if an attorney makes an appearance on behalf of a party, and thereafter the party files a written power of attorney to another attorney, the Board will send subsequent correspondence to the appointed attorney.

If a power of attorney from a party to one attorney has been filed, and thereafter that attorney files an "associated power of attorney" to another attorney, the correspondence address will remain unchanged, and the Board will continue to send correspondence to the first attorney, unless the first attorney or the party directs otherwise.

In the case of a party whose application is the subject of a Board proceeding, any appearance or power of attorney (or designation of other authorized representative) of record in the application file at the time of the commencement of the Board proceeding is considered to be effective for purposes of the proceeding, and correspondence will be sent initially to that address. Thereafter, the correspondence address may be changed as described in Trademark Rule 2.18.

In the case of a party whose registration is the subject of a Board proceeding, any representative which may be of record in the registration file at the time of the commencement of the Board proceeding is not considered to be effective for purposes of the Board proceeding. Rather, correspondence is sent to the registrant itself unless and until another correspondence address is established in the manner described in Trademark Rule 2.18.

## THE TRADEMARK TRIAL AND APPEAL BOARD WOULD LIKE YOU TO KNOW:

The TTAB Customer Service Center is available to

- \*answer telephone inquiries
- \*explain pertinent legal provisions and related administrative practices as they apply to specific cases
- \*provide status information on pending cases
- \*provide access to the files of pending cases
- \*resolve problems

The telephone number for the TTAB Customer Service Center is (703) 308-9300, extension 0 [zero].

The Patent and Trademark Office has two special boxes for expedited processing and distribution of documents filed with the TTAB. Envelopes and transmittal letters for TTAB should be addressed to: Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202, followed by one of the following designations

"Box TTAB Fee": for papers filed with the TTAB that include filing fees, such as notices of opposition, petitions to cancel, and notices of ex parte appeal  
and

"Box TTAB": for all non-fee papers filed with the TTAB, such as requests for extensions of time to file notices of opposition and motions.

The TTAB Customer Service Center makes every effort to provide public access to application files, opposition files, cancellation files and concurrent use files immediately upon request for access. Files located will be made available in a central storage area accessible to the public. You can also access information about TTAB proceeding files online. Go to <http://www.uspto.gov/web/offices/dcom/ttab/> and click the "BISX LINK".

Any questions, comments, or suggestions concerning TTAB service should be directed to Jean Brown, TTAB Technical Program Manager, at (703) 308-9300, extension 123 or Afendi Ziad, Supervisory Legal Assistant at (703) 308-9300, extension 205 or Angela Pope, Supervisory Legal Assistant at (703) 308-9300, extension 144.

## NOTICE CONCERNING ALTERNATIVE DISPUTE RESOLUTION (ADR)

The Trademark Trial and Appeal Board encourages you to consider alternative dispute resolution as a means of settling the issues raised in this opposition or cancellation proceeding. Although more than 95% of Board proceedings are decided prior to trial (by settlement or by entry of pre-trial judgment), alternative dispute resolution techniques might produce an earlier, mutually agreeable resolution of your dispute or might, at least, narrow the scope of discovery or the issues for trial. In either case, alternative dispute resolution might save you time and money.

Many non-profit organizations, both inside and outside the intellectual property field, offer alternative dispute resolution services. Listed below are the names and addresses of organizations that have indicated that they can make arrangements for alternative dispute resolution. The listings are given for your convenience; the Board does not sponsor nor endorse any particular organization's alternative dispute resolution services.

<b>International Trademark Association</b> Telephone: (212) 642-1726 Fax: (212) 768-7796 <a href="http://www.inta.org/adr/index.shtml">www.inta.org/adr/index.shtml</a> e-mail: <a href="mailto:lstigliano@inta.org">lstigliano@inta.org</a>	<b>CPR Institute for Dispute Resolution</b> Telephone: (212) 949-6490 Fax: (212) 949-8859 <a href="http://www.cpradr.org">www.cpradr.org</a> e-mail: <a href="mailto:info@cpradr.org">info@cpradr.org</a>
<b>American Intellectual Property Law Association (AIPLA)</b> 2001 Jefferson Davis Highway Suite 203 Arlington, Virginia 22202 Telephone: (703) 415-0780 Fax: (703) 415-0786	
<b>American Arbitration Association (AAA)</b> Headquarters 140 West 51 <sup>st</sup> Street New York, New York 10020-1203 Telephone: (212) 484-3266 Fax: (212) 307-4387	

Finally, if the parties consider using alternative dispute resolution in this proceeding, the Board would like to know; and if the parties actually engage in alternative dispute resolution, the Board would be interested to learn what mechanism (e.g., arbitration, mediation, etc.) was used and with what general result. Such a statement from the parties is not required but would be helpful to the Board in assessing the value of alternative dispute resolution in Trademark Trial and Appeal Board proceedings.

# PROCEEDING SYNOPSIS

United States Patent and Trademark Office Trademark Trial and Appeal Board

Trademark Opposition and Cancellation Proceedings Under 15 USC 1062, 1064, 37 CFR 2.101 et seq.

## **FILING OPPOSITION/CANCELLATION**

Any person (Opposer) may file a Notice of Opposition within 30 days against any mark published under 15 USC 1062(a) in Official Gazette; may oppose in whole or part.

Time for filing Notice may be extended by written request to TTAB. A first extension for not more than 30 days will be granted upon request. Further extensions may be granted for good cause. Extensions aggregating more than 120 days from pub. date not granted unless consented to by applicant or extraordinary circumstances. 37 CFR 2.102(c). Request should be in triplicate. 37 CFR 2.102(d).

Any person (Petitioner) may file a Petition to cancel a registration in whole or in part, but only under conditions set forth in 15 USC 1064.<sup>2</sup> Geographic limitation will be considered by TTAB only in concurrent use proceeding. 37 CFR 2.99(h), 2.133(c).

Opposer/Petitioner is in position of Plaintiff and Applicant/Respondent is Defendant. 37 CFR 2.116(b).

Notice/Petition corresponds to complaint in civil action. 37 CFR 2.116(c).

Amendment to pleadings in accord with Rule 15, Fed. Rules of Civil Procedure (FRCP). 37 CFR 2.107, 2.115.

## **MAILING PROCEDURES**

Certificate of Mailing or Transmission and Express Mail procedures effective for all papers. 37 CFR 1.3, 1.10.

## **INSTITUTION OF PROCEEDING; WITHDRAWAL**

TTAB examines Notice/Petition for formal requirements and sends notification to Defendant, generally within few weeks of filing date. Duplicate copy of Notice/Petition and Exhibits sent to Defendant. 37 CFR 2.105, 2.113.

Notice/Petition may be withdrawn without prejudice before Defendant files Answer. 37 CFR 2.106(c), 2.114(c). With written consent of Defendant, later withdrawal may be without prejudice.

Defendant may not abandon application or surrender registration without prejudice except with written consent of Plaintiff. 37 CFR 2.135, 2.134.

## **ANSWER; MOTIONS**

Time for Answer set by TTAB for 40 days from Notification mailing date.<sup>3</sup> Counterclaim should be filed with answer or promptly upon discovery of information supporting Counterclaim. 37 CFR 2.106(b), 2.114(b).

Time for reply to Counterclaim set by TTAB for not less than 30 days from TTAB action mailing date. 37 CFR 2.106(b), 2.114(b).

Motions may be brought before TTAB in writing and with Brief in support. Brief in opposition thereto, 15 days (30 days for summary judgment motion). Briefs limited to 25 pages. Reply Brief, if filed, 15 days, limited to 10 pages. Reconsideration 30 days after decision; Opposition Brief, 15 days. 37 CFR 2.127. Most motions used in Federal practice are applicable.

Motions for Summary Judgment, to Compel, and to Test Sufficiency of Responses to Requests for Admissions, if filed, due before Plaintiff testimony period opens. 37 CFR 2.127(e), 2.120(e), 2.120(h).

## **TRIAL DATES**

TTAB issues Order setting opening and close of Discovery and Trial dates. Discovery set for period of 180 days; 30-day Pl. Testimony period closes 90 days after close of Discovery period; 30-day Def. Test. period closes 60 days after Pl. Test. period; 15-day Pl. Rebuttal Test. period closes 45 days after Def. Test. period. 37 CFR 2.120(a), 2.121.

In cases where Counterclaim filed, TTAB sets additional time periods for testimony and briefing.

## **DISCOVERY PERIOD**

Interrogatories, Reqs. for Prod. Of Docs. & Things, and Reqs. for Adm., if served, must be served by last day of Discovery period. Written Responses within 30 days from date of service of Disc. Reqs. FRCP apply except as otherwise provided. 37 CFR 2.116, 2.120(a). Extension of time to respond to discovery granted upon cause or by stipulation.

Interrogatories limited to proceeding total of 75, counting subparts; additional interrogatories allowed upon motion for good cause or by stipulation. 37 CFR 2.120(d)(1).

Discovery Depositions (noticed and taken within Disc. Period) in District where deponent resides or is employed. 37 CFR 2.120(a), 2.120(b). Either party may request designation of witnesses under FRCP 30(b)(6), 31(a).

## **PLAINTIFF'S TRIAL PERIOD**

Plaintiff's Testimony-In-Chief. Opens 60 days after Discovery Period closes, and runs for 30 days (refer to Order).

Testimony taken by deposition upon oral examination or upon written questions. 37 CFR 2.123, 2.124.

Plaintiff serves Transcript of testimony and copies of documentary exhibits on adverse party within 30 days after completion of taking testimony. Certified transcript and exhibits filed with TTAB. 37 CFR 2.125.

Notice of Reliance as appropriate on Discovery Deps., Adms. and Int. Answers, with copies of same, due before close of Test. 37 CFR 2.120.

Involved app. or reg. files are in evidence for relevant and competent purposes. Publications in gen. Circ. or in libraries, and official records, may be received if appropriate Notice of Reliance is filed and copies submitted within Test. period. 37 CFR 2.122.

Motion under 37 CFR 2.132, if filed, due after close of Pl.'s Test. period & before opening of Def.'s.

## **DEFENDANT'S TRIAL PERIOD**

Opens 30 days after close of Pl.'s Test. period. Runs for 30 days.

Test. taken by deposition upon oral examination or upon written questions. 37 CFR 2.123, 2.124.

Notice of Reliance on Discovery responses also due within Test. period, if filed. 37 CFR 2.120.

Notice of Reliance on gen. circ. publ. and official records due within Test. period, if filed. 37 CFR 2.122.

Def. serves Test. transcript on Pl. within 30 days and files certified transcript and exhibits with TTAB. 37 CFR 2.125.

## **PLAINTIFF'S REBUTTAL PERIOD**

Rebuttal Test. period for Pl. opens 30 days after close of Def.'s Test. period and runs for 15 days.

Pl. may file Notice of Reliance under 37 CFR 2.120, 2.122, with matter relied on, and take Test. to rebut Def. Test. and other evidence.

Pl. serves and files Transcript of Rebuttal Test. and exhibits in accordance with 37 CFR 2.125.

## **BRIEFS; ORAL HEARING**

Pl. Brief due 60 days after Rebuttal period closing.

Def. Brief, if filed, due 30 days after Pl. Brief due.

Pl. Reply Brief, if filed, due 15 days after Def. Brief due. 37 CFR 2.128.

Separate Request for Oral Hearing, if filed, due not later than 10 days after Reply Brief due. 37 CFR 2.129.

TTAB Notice of Oral Hearing sent to all parties.

Oral Hearing before panel of at least three TTAB judges. 30 minutes for each party. 37 CFR 2.129.

DECISION; RECONSIDERATION; APPEAL

TTAB Deliberation. Writing of Opinion and Decision in due course.

Request for rehearing, reconsideration or modification, if filed, due within one month. Brief

opposition due within 15 days. 37 CFR 2.129(c).

Any Appeal from TTAB Decision due within two months of Decision or two months after denial of req. for recon. See especially 37 CFR 2.129(d).

NOTE: Footnotes and TTTAB addresses and telephone number appear on the back of this sheet

**FOOTNOTES**

- (1) Opposer may be any legal entity including a corporation. Opposer must believe that opposer would be damaged by registration of the mark and state the reasons. 15 USC 1063 and 37 CFR 2.101. Notice of Opposition need not be verified. \$300 required fee for each class for each person opposing. 37 CFR 2.6, 2.101(b). May be signed by attorney. 37 CFR 2.101(b). Duplicate copy including exhibits required. Order status and title copies of pleaded registrations in advance and attach to Notice/Petition or introduce as evidence during Testimony-In-Chief period. 37 CFR 2.122.
- (2) Action, grounds and requirements (Footnote 1) for initiation of Cancellation proceeding are similar to those for an Opposition proceeding and are covered in 15 USC 1064, 1092 and 37 CFR 2.111, 2.112. \$200 required fee per class, per person. Duplicate copy required.
- (3) Except Notice/Petition, each paper must be served on opponent. Statement of service (date and manner) is required. Period to respond to Motions and Discovery Requests is extended 5 days when service is by first-class mail, "Express Mail," or overnight courier. 37 CFR 2.119. Action due on weekend or D.C. holiday can be taken on next business day. 37 CFR 1.7.
- (4) Resetting of time to respond to Discovery Request does not result in extension of Discovery period and subsequent testimony periods unless requested. 37 CFR 2.120(a). All consented extensions of time should be filed in triplicate and list specific dates for all subsequent periods affected.
- (5) Except for 37 CFR 2.122(e) documents, documents produced in response to Requests for Production cannot be made of record by Notice of Reliance alone. 37 CFR 2.120(j)(ii).
- (6) Briefs should be typewritten or printed, double-spaced, in at least pica or eleven-point type, on letter paper (8½ x 11). Three copies of briefs required. Alphabetical index of cases required. Length limit of 55 pages, including table of contents, index of cases, description of record, statement of issues, recitation of facts, argument, and summary. Reply brief 25 pages total. 37 CFR 2.128(b).

**ADDRESSES AND TELEPHONE**

**All papers not requiring a fee should be mailed to:**

**Box TTAB No Fee  
Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, Virginia 22202-3513**

**NOTE: For papers with fee, use "Box TTAB Fee"**

**TTAB Office Location and Telephone Number**

**2900 Crystal Drive  
South Tower, Suite 9B40  
Arlington, Virginia 22202-3513**

**Telephone: (703) 308-9300**





**UNITED STATES DEPARTMENT OF  
COMMERCE  
Patent and Trademark Office  
Trademark Trial and Appeal Board  
2900 Crystal Drive  
Arlington, Virginia 22202-3513**

Mailed: February 24, 2004

Cancellation No.92042614

Jackson/Charvel  
Manufacturing, Inc.

v.

Prins, Lloyd A.

**Millicent Canady, Legal Assistant**

Answer was due in this case on December 21, 2003. Inasmuch as it appears that no answer has been filed, nor has respondent filed a motion to extend its time to answer, notice of default is hereby entered against respondent under Fed. R. Civ. P. 55(a).

Respondent is allowed until thirty days from the mailing date of this order to show cause why judgment by default should not be entered against respondent in accordance with Fed. R. Civ. P. 55(b).



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of  
Trademark Registration No. 2,772,766  
For the Mark SAN DIMAS GUITARS THE  
CALIFORNIA GUITAR COMPANY  
Registration Date: October 7, 2003

JACKSON/CHARVEL MANUFACTURING,  
INC.,

Cancellation No. 92042614

Petitioner,

v.

PRINS, LLOYD A.,

Registrant

Box TTAB No Fee  
United States Patent and Trademark Office  
2900 Crystal Drive  
Arlington, Virginia 22202-3513

**MOTION FOR AN EXTENSION TO ANSWER**

Registrant, Prins, Lloyd A. (Prins) respectfully moves that the Board grant an Extension To Answer and set aside its Notice of Default dated February 24, 2004. Included with this motion is a request to reset the opening and closing dates for the discovery and testimony period. The following statements are provided in support of this motion:

1. On October 24, 2003 Jackson/Charvel Manufacturing, Inc. filed a Petition for Cancellation initiating a matter before the Commissioner for Trademarks.
2. Pursuant to CFR 2.113 (c), a copy of the petition for cancellation and any exhibits are to mailed to the registrant/respondent.
3. Although the Board has the correct mailing address for Prins, notification of the proceedings and instructions for answering were never received.

4. Prins' first knowledge of the petition for cancellation was in early February 2004, while reviewing his awarded trademark at the USPTO website. Prins immediately mailed a registered letter (U.S. Postal Service article number 7003 1680 0006 5170 0727) to the USPTO requesting instructions for a proper reply (A copy of this letter is attached). This letter was received at the office of the Commissioner of Trademarks on February 12, 2004. A courtesy copy was mailed to, and acknowledged receipt by, the Petitioner.

5. To date, Prins has not received from the Board a copy of the petition, instructions for replying, or timetable for the proceedings.

Accordingly, Lloyd Prins respectfully requests that the Board accept this motion to extend the time to answer and set aside its motion of default in this matter.

Respectfully Submitted

 3/22/04

Lloyd A. Prins

Date

San Dimas Guitar  
Company  
2323 Via Saldivar  
Glendale, CA 91208

## COPY OF LETTER SENT

February 9, 2004

Commissioner of Trademarks  
2900 Crystal Drive  
Arlington, VA 22202-3514

Dear Commissioner of Trademarks:

**Subject: Registration mark 2,772,766**

While researching my awarded trademark "San Dimas Guitars The California Guitar Company" on the Internet, I learned that a cancellation proceeding has been filed with the Trademark Trial and Appeal Board. I also learned that the Fender Musical Instrument Corporation (FMIC) has recently applied for a trademark that is similar to my awarded mark. This leads me to believe that FMIC is the party that filed for the cancellation.

This is the first that I have learned of these proceedings. I assume that some response from me is expected, but being unfamiliar with these matters, I have no idea how to respond or in what format. In order to prepare an appropriate reply, it would be helpful if I had a copy of FMIC's filing.

As a courtesy, I am sending a copy of this letter to FMIC.

Thank you for your attention to this request. I hope to hear from you soon.

Sincerely,

Lloyd Prins

cc: FMIC  
8860 E. Chaparral Road  
Scottsdale, AZ 85250

## COPY OF LETTER SENT

**Certificate of Mailing and Notice of Service**

**Certificate of Mailing (37 C.F.R. 1.10)**

I certify that a copy of this Motion For Extension To Answer was mailed on March 22, 2004 via U.S. Mail, article number 7003 1680 0006 5170 5562. This item was deposited with sufficient postage and was addressed to:

Box TTAB No Fee  
United States Patent and Trademark Office  
2900 Crystal Drive  
Arlington, Virginia 22202-3513

**Notice of Service**

I also certify that a copy of this Motion For Extension was mailed to the Petitioner on March 22, 2004 via U.S. Mail, article number 7003 1680 0006 5170 5579. This item was deposited with sufficient postage on March 22, 2004 and addressed to:

Mr. Michael K. Hendershot  
Goldberg Kohn  
55 East Monroe Street  
Suite 3700  
Chicago, IL 60603-5802

Lloyd A. Prins      March 22, 2004

**CERTIFICATE OF SERVICE**

The undersigned, an attorney, hereby certifies that on March 31, 2004, he caused a copy of the attached **Petitioner's Response in Opposition to Respondent's Motion for Extension to Answer**, to be served via U.S. mail, postage pre-paid, upon:

Lloyd A. Prins  
San Dimas Guitar Company  
2323 Via Saldivar  
Glendale, California 91208



Salvador K. Karottki



March 31, 2004

sal.karottki@goldbergkohn.com  
direct phone: 312.201.3861  
direct fax: 312.863.7861



BOX TTAB/NO FEE  
UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
2900 Crystal Drive  
Arlington, Virginia 22202-3513

03-31-2005  
U.S. Patent & TMO/c/TM Mail Rcpt Dt. #78

**Re: JACKSON/CHARVEL MANUFACTURING, INC. v. PRINS, LLOYD A.  
CANCELLATION NO. 92042614**

Dear Sir or Madam:

Please find enclosed the Petitioner's Response in Opposition to Respondent's Motion for Extension to Answer in connection with the above-referenced matter (Cancellation No. 92042614).

Please contact me if you have any questions or comments in this regard.

Best regards,

Salvador K. Karottki

SKK.cb

Enclosure

cc: Lloyd A. Prins